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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Chappa, et al.

Serial No.: 10/028,518

Filed: 21 December 2001

For: REAGENT AND METHOD FOR  
PROVIDING COATINGS ON SURFACES )

To: Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

) Art Unit 1762

) Our Ref. 9896.149.0

) Examiner: Jennifer K. Michener

I hereby certify that this correspondence is being:

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on this 6<sup>th</sup> day of July, 2004

By Joyce Thomas

RESPONSE TO SUPPLEMENTAL ACTION

This response replaces an earlier filed response, and is provided in response to receipt of a supplemental detailed action, mailed June 8, 2004, the unextended period for response to which is set to expire July 8, 2004. In the initial Office Action mailed March 29, 2004, the Examiner has required restriction to one of the following inventions under 35 U.S.C. § 121:

- I: Claims 1-20, drawn to a method of forming a polymeric coating
- II: Claims 21-30 and 32-42, drawn to a support surface
- III: Claim 31, drawn to a composition system

In response to the restriction requirement, Applicants provisionally elect Group II (Claims 21-30 and 32-42) with traverse.

Applicants traverse the restriction requirement on the grounds that no serious burden on the Examiner exists. If the search and examination of an entire application can be made without serious burden, it must be examined on the merits even though it includes claims directed to

distinct or independent invention. M.P.E.P § 803. The subject matter of Groups I, II and III are believed sufficiently related that a thorough search for the subject matter of any one group would encompass a search for the subject matter of all groups. To avoid duplicative examination by the Patent Office and unnecessary delay and expense to Applicant, Applicant respectfully requests examination on the merits of all the claims, not just those of Group II.

Furthermore, Applicant submits that if a determination of an allowable generic claim is issued, claims that are written in dependant form or otherwise include all the limitations of the allowed generic claim should be considered. M.P.E.P. § 809.02(c). Therefore, the Applicant respectfully requests that the Examiner consider rejoining the method claims of Groups I, II and III upon a finding of allowability of the claims of Group II.

Accordingly, reconsideration and withdrawal of the restriction requirement is respectfully requested.

The Examiner has also required an election of species under 35 U.S.C. § 121. The election of species was divided into two parts. First, an election of a species between various medical devices, biomedical devices, and porous support surfaces was required. Second, an election of species from the polymerizable monomers of claims 11, 27, 30, 40, and 42, and those of claims 12, 20, 27, and 40 was required.

With regard to the first election, applicant elects porous support surfaces, with traverse. It would appear that claim 21 is generic for support surfaces, which includes all of the species identified by the Examiner, and thereby would read on both the elected and non-elected species. With regard to the second election, applicant elects acrylamide as a species of the genera “polymerizable monomers”, with traverse. Generic claims for polymerizable monomers within

the elected group are claims 21, 27, and 40. Again, these claims include all of the species identified by the Examiner, and thereby would read on both the elected and non-elected species.

MPEP 802.02 clearly provides that an election of species requirement is merely a type of restriction requirement. As such, the present Office Actions fails to meet *either* of the two fundamental requirements of *any* restriction requirement, as set forth in MPEP 808, namely, that it provide: (1) reasons why the inventions *as claimed* are either independent or distinct, *and* (2) reasons for insisting on restriction therebetween. Accordingly, the election of species requirement fails to meet the Office's own standards and should be withdrawn. Moreover, the rules (37 CFR 1.141) provide that a reasonable number of species may be included in a single application, where, as here, other conditions are met.

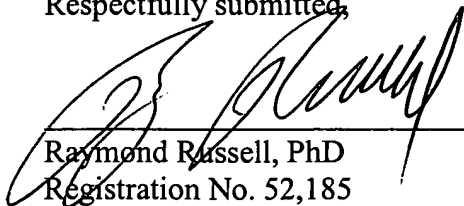
It is to be understood that this election of species is for the sole purpose of the Examiner's initial search and examination, and that upon allowance of a generic claim, all species encompassed by that claim will then be examined. M.P.E.P. § 809.02(c). Therefore, Applicant respectfully requests that the search be conducted pursuant to Markush practice thereby providing for the inclusion of all species included in the generic claim and all claims dependent thereon.

The Commissioner is hereby authorized to charge any additional filing fees required to Deposit Account No. 061910. A duplicate copy of this sheet is enclosed.

Dated: \_\_\_\_\_

7/6/04

Respectfully submitted,

  
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Raymond Russell, PhD  
Registration No. 52,185  
Fredrikson & Byron, P.A.  
4000 Pillsbury Center  
200 South Sixth Street  
Minneapolis, MN 55402-1425  
(612) 492-7225  
Customer No. 022859

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